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Re:	Application of:	John A. Moore
	Serial No.:	10/758,061
	Filed:	January 15, 2004
	For:	Method And System For Managing Image Files In A Hierarchical Storage Management System
	Group Art Unit:	2162
	Confirmation No.:	5102
	Examiner:	Giovanna B. Colan
	MMB Docket No.:	1776-0014
	Xerox Docket No.:	D/A 2451

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets. This paper is filed by the Attorney of Record.

REMARKS

Reasons for Review

The Examiner has failed to make a *prima facie* case of obviousness with respect to claims 1, 3-10, 12-15, and 17-20. In general, the clear error in the Examiner's ground of rejection is that neither of the references in the cited combination teach or suggest the limitations for which the Examiner cites them. Because the references fail to disclose the limitations of the independent claims, the Examiner's ground of rejection under 35 U.S.C. 103(b) as to all of the pending claims must fail.

Discussion of Missing Limitations

Claim 1 requires "identifying an image file stored in secondary storage for a host system" and "storing the downgraded file in the secondary storage of the host system." Claim 1 also requires that the downgraded file be generated from the identified image file. The Examiner asserts that Toda, U.S. Publication 2002/0037100 (hereinafter "Toda"), discloses these limitations. Specifically, the Examiner states that Toda teaches the identification of an image file stored in secondary storage for a host system at page 8, paragraph [135], lines 5-10. That portion of Toda is directed to the fifth embodiment of an image compression system and discusses components of the system, but no image file identification is set forth in the cited paragraph. The deficiency of that paragraph, however, is not fatal as the fifth embodiment is described as loading a color document image from the external storage device, image input device, or storage medium drive into the system's RAM. Toda, paragraph [0141]. Thus, properly interpreted, Toda teaches that an external storage device, image input device, or storage medium drive operate as secondary storage for a color image. In order for the second limitation quoted above to be disclosed by Toda, the downgraded file, which is generated from the identified image file in claim 1, would have to be stored in the secondary storage from which the color image was obtained. Toda, however, does not provide any indication of where the compressed file, which is generated from the color image, is stored. The only embodiment description that refers to a destination for a compressed file is the first embodiment, which states the compressed file is attached to an email message. Toda, paragraph [0083]. The absence of such a teaching is not surprising as Toda focuses on an

image compression system and not on a hierarchical storage management system.

Claim 1 also requires that the identified image file be stored in tertiary storage of the host system that has an access time that is greater than the access time for the secondary storage for the host system. The Examiner admits that Toda does not disclose this limitation, but asserts the limitation is taught by Baba, U.S. Publication Number 2001/0014172 (hereinafter “Baba”). The portion of Baba cited by the Examiner, namely, paragraph [0102], states that image data processing is performed in an internal memory device and that original image data are stored in an external storage device, such as a “hard disc drive device.” The external storage device is described as being slow in processing speed.

The limitation of claim 1 requires “tertiary” storage and neither the internal memory device nor the external storage device of Baba qualifies as tertiary storage. Reference to a dictionary indicates that “tertiary” means third in order. Baba, however, does not refer to three types of storage, but only two. Therefore, Baba does not teach the storage of an identified image file in tertiary storage having an access time that is greater than the access time for the secondary storage. In fact, Toda, if anything, appears to teach moving a file from the external storage device to the internal memory device, which is faster, i.e., has a *shorter* access time, than the external storage device. Therefore, Toda teaches away from the claim limitation requiring storing of the identified image file in tertiary storage having an access time that is greater than the secondary storage of the host system. Adding Baba to Toda does not result in the method of claim 1.

The cited references also fail to teach or suggest the limitations of independent claim 15. Besides the absence of a file controller that stores the downgraded file in the secondary storage of the host system and the identified image file in tertiary storage for reasons similar to those discussed above with reference to claim 1, Toda also fails to teach a file data volume for storing file metadata that corresponds to image files stored in a secondary storage for a host system. The paragraphs of Toda cited by the Examiner, [0055], [0056], and [0142] do not disclose a file data volume that stores file metadata that corresponds to image *files*. The

histograms of paragraphs [0056] and [0142] are developed from a single original image. Not only is a histogram for only a single image described, but there is no teaching or suggestion that multiple histograms corresponding to image files stored in secondary storage of the host system be stored in a file data volume. The RAM of paragraph [0056] and [0142] is not described as containing multiple histograms for multiple images stored in secondary storage of the host system. The histogram of Toda is stored in volatile memory only for the compression of a single image and Toda is void of a teaching that the histogram be stored before the next histogram is developed from the next processed image. Thus, the RAM of Toda does not operate as a file data volume for storing file metadata that corresponds to image files stored in a secondary storage for a host system.

Conclusion

For all of the foregoing reasons, Applicant respectfully submits that the cited combination of Toda in view of Baba does not teach or suggest the limitations of the independent claims 1 and 15. The dependent claims 3-10, 12-14, and 17-20 also include these limitations. Therefore, the section 103(a) ground of rejection based on the cited combination is not properly supported by the references and the final office action should be withdrawn. Favorable reconsideration and allowance of this application is, therefore, earnestly solicited.

Respectfully Submitted,

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